

(3) **Claim Rejection - 35 U.S.C. 102(b) – Anticipation**

(a) **Statement of the Law**

Anticipation can only be established by a single prior art reference: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

(b) **Applicant’s Submissions**

**Claim 1**

The Examiner asserts that Strickland anticipates claim 1. To anticipate claim 1 the law requires that Strickland have all of the features of the claim, in exactly the same situation and united in the same way to perform the same function.

Contrary to the Examiner’s rejection, the applicant respectfully submits that, as more fully explained below:

- (1) Strickland does not disclose first and second collapsible insulated container portions having respective first and second *insulated* wall structures, the insulated wall structures including respective *insulated* sidewall panels. More specifically, Davis does not teach the insulated feature of the claimed *insulated* sidewall panels;
- (2) Strickland does not have a portion of the first insulated wall structure being moveable to close the first opening; and

- (3) Strickland does not teach or describe the first chamber being maintainable at a different environmental condition from the second chamber.

The applicant submits that any one of these differences is sufficient to overcome the rejection of claim 1 under 35 U.S.C. §102(b) according to *Dart Industries* and *Datascope, supra*.

Explanation of Grounds of Traverse

(i) Strickland describes a baby bottle caddy 10 having four interior compartments 11a of generally square cross-sectional configuration, for receiving baby bottles 14. The interior compartments 11a are defined by a first interior wall 11 and "...a plurality of orthogonally directed and arranged interior partitions 12 interiorly of the interior wall 11..." (see col. 3, lines 61 to 66 and Figure 3). Strickland teaches that first interior wall 11 is formed of a polymeric flexible non-rigid material. However, Strickland is silent as to whether the first interior wall is insulated. Similarly, Strickland provides no indication as to whether the interior partitions 12 are insulated. In sum, Strickland neither discloses, describes nor suggests that either of first interior wall 11 or interior partitions 12 are insulated.

(ii) The configuration and functionality of the Strickland baby bottle caddy tends to strongly suggest that the sidewalls of the interior compartments 11a are not insulated. For example, the baby bottle caddy 10 is constructed such that the first interior wall 11 is secured to a second cup-shaped portion 16. The vertical sides of the second cup-shaped portions 16 are spaced from the interior wall 11 to define a gap 15 about the perimeter of the interior wall. Gap 15 accommodates refrigerant containers 23. Refrigerant containers 23 are used to cool bottles 14 positioned in the compartments 11a (see col. 4, lines 2 to 8 and Figures 2 and 3). It follows then that if bottles 14 are to be cooled, the sidewall panels of the interior wall 11 must allow heat to be transferred between refrigerant container 23 and bottles 14. However, effective heat transfer would be impeded if the sidewalls were insulated. Given that having insulated sidewall panels would interfere with cooling of the bottles 14 by the refrigerant containers 23, the functionality of baby bottle caddy would tend to dictate that the sidewall panels of interior compartments 11a are not insulated.

(iii) In light of the foregoing, the applicant submits that Strickland does not disclose first and second collapsible insulated container portions having respective first and second *insulated* wall structures, the insulated wall structures including respective *insulated* sidewall panels.

(iv) In the event that the Examiner sustains the rejection of claim 1 on the basis Strickland, the applicant notes that it would be helpful if the Examiner could provide a column or line reference in the text of Strickland referring to the insulated feature of either the first interior wall 11 or the interior partitions 12; or (b) an annotated copy of any of figures of Strickland in which the insulated feature of the first interior wall 11 or the interior partitions 12 are identified, in order to permit the applicant to understand more clearly the basis for the rejection.

(v) It is further respectfully submitted that the specification of Strickland neither describes nor teaches that a portion of the first insulated wall structure is moveable to close the first opening. As can be seen in the Figures, first interior wall 11, interior partitions 12 and floor 13 co-operate to define four, open-topped interior compartments 11a. Access to the interior compartments 11a is controlled by a cover flap 18. Cover flap 18 is pivotally connected to a third exterior wall in the nature of a water impervious shell 17. Strickland states at col. 4, lines 18 to 23:

“A third exterior water impervious shell 17 is of a cup-shaped configuration and secured to an exterior surface of the second cup-shaped portion 16. The shell 17 includes a pivoted cover flap 18 seamed along a hinged end 19 with the three remaining ends securable to the shell 17 by a continuous zipper 20.”

As described in the foregoing passage, cover flap 18 is a portion of the exterior shell 17. Cover flap 18 is not a portion of the wall structure of one of the interior compartments 11a. Accordingly, it cannot be said that the wall structure of interior compartments 11a, that is, first interior wall 11 and interior partitions 12, are moveable to close the opening of an interior compartment 11a. In light of the foregoing, the applicant respectfully submits that Strickland cannot serve as an anticipatory reference as it does not teach each and every feature of the applicant's claim 1.

(vi) In re Hutchison

In the context of the rejections based on Strickland, the Examiner has cited *In re Hutchison* 69 USPQ 138 as standing for the proposition that “it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a patentable limitation in any sense”.

The applicant respectfully disagrees,

- (a) that *Hutchison* is still good law in the context for which it is employed by the Examiner; and
- (b) that functional limitations “do not constitute a patentable limitation in any sense”.

As a preliminary matter, even if *Hutchison* stood for the proposition stated by Examiner, the test for anticipation nonetheless requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries, supra*. (Emphasis added). A person reading the claim cannot then ignore functional language in the claim, (even if such it be). To the extent that *Hutchison* would indicate to the contrary, *Hutchison* is clearly no longer good law, if it ever was.

*Hutchison* was decided in 1946 – before the patent law amendments of 1952 which enshrined the permissibility of use of functional language in claims under U.S. law. *Hutchison* was implicitly overruled on the point in question by *In re Land and Rogers*, 151 USPQ 621 (CCPA 1966) (See, in particular at pp. 635 – 636). This position was further reinforced by the CCPA in *In re Swinehart and Sfiligoj*, 169 USPQ 226 (CCPA 1971) (See, in particular at pp 228 – 229).

The applicant notes that, not surprisingly, *In re Hutchison* is no longer cited in the relevant sections of the MPEP. The MPEP currently reads, in part, as follows:

#### **2173.05(g) Functional Limitations**

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like an other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. (Emphasis added).

...

It was held that the limitation used to define a radical on a chemical compound as “incapable of forming a dye with said oxidising developing agent” although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

In a claim that was directed to a kit of component parts capable of being assembled, the court held that limitations such as “members adapted to be positioned” and “portions ... being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia* 530 F.2d 956, 189 USPQ 149 (CCPA 1976).

Clearly, *In re Barr* removes any doubt about whether “capable of”, or “incapable of” are acceptable. Not only is *Hutchison* no longer good law, but the position taken by the Examiner on the basis of *Hutchison* is directly contrary to the position of the Commissioner as expressed in MPEP 2173.05(g), and by which the Examiner is bound.

In the present instance, the term “maintainable” as it is used in claim 1 expresses a feature of the claimed insulated container. To paraphrase *Venezia*, it serves to define structural attributes (i.e., different environmental conditions) of interrelated component parts (the first and second chamber) of the claimed assembly (the insulated container).

Accordingly, the applicant respectfully requests that the Examiner acknowledge that *Hutchison* is no longer good law and reconsider the patentability of claim 1 in light of Strickland in view of the limitation that the first chamber is maintainable at a different environmental condition from the second chamber. In particular, the applicant invites the Examiner to consider the comments set out below.

(vii) Strickland neither describes nor teaches that one interior compartment 11a is maintainable at a different environmental condition than another interior compartment 11a. The specification of Strickland merely contemplates that bottles 14 stored within interior compartments 11a will be cooled by refrigerant containers 23 placed in gap 15. There is nothing in the description of Strickland to suggest that one interior compartment 11a is maintainable at a different environmental condition than another interior compartment 11a. In addition, there is no inherent reason for positing that the baby bottle caddy 10 of Strickland has the claimed feature. To the contrary, the fact that the wall structures of interior

compartments 11a are not insulated would tend to suggest that the interior compartments are not intended to be maintainable at different environmental conditions. Accordingly, Strickland cannot serve as an anticipatory reference as it does not teach each and every feature of the applicant's claim 1.

#### Claims 2 and 4

To the extent applicable, the applicant repeats the commentary made in the context of claim 1 with regard to Strickland. In addition, the applicant respectfully submits that Strickland neither teaches nor describes an insulated container portion having a liner for containing liquids mounted within its chamber. This feature is thus missing from the baby bottle caddy 10 of Strickland. Accordingly, Strickland cannot anticipate claim 2, or any claim dependent therefrom. The applicant respectfully submits that claims 2 and 4 are allowable over Strickland.

In the event, the Examiner sustains his rejection of claims 2 and 4 on the basis of Strickland, the applicant respectfully requests under MPER 707.07(f), that the Examiner provide a column or line reference at which Strickland refers to the liner of internal compartment 11a; or (b) an annotated copy of any of figures of Strickland with the alleged liner identified, in order to permit the applicant to understand the precise basis for the rejection.

#### Claims 19 - 22

To the extent applicable, the applicant repeats the commentary made in the context of claim 1 with regard to Strickland. The applicant respectfully submits that claims 19 - 22 are allowable over Strickland.

#### Claim 28

In the context of claim 28, the applicant repeats the arguments asserted in connection with claim 1 to the extent applicable. In particular, the applicant respectfully requests that the Examiner acknowledge that *Hutchison* is no longer good law and reconsider the patentability of claim 28 in light of Strickland in view of the limitation that the first container portion is moveable between an expanded position and a collapsed position relative to the common wall, and the first container portion is securable in the collapsed position.

In addition, the applicant respectfully submits that Strickland: (1) does not show a first container portion being movable between an expanded position and a collapsed position relative to the common wall; and (2) does not teach that the first container portion is securable in the collapsed position.

As stated previously, Strickland describes four internal compartments 11a being formed by a first interior wall 11, interior partitions 12 and floor 13. As shown in Figure 3, an interior partition 12 defines a common wall between two adjacent internal compartments 11a. Strickland also teaches that the baby bottle caddy 10 is maintained in a first extended position (or erected configuration) when bottles 14 are stored therewithin and is collapsible to a second collapsed position upon removal of the bottles 14 therefrom. In this regard, the specification of Strickland provides at col. 4, lines 8 to 17 provides as follows:

“The bottles 14 are formed of a rigid plastic-like material of complementary cross-section configuration and shape to the compartments 11a whereupon positioning of the bottles 14 within the compartments 11a, the baby bottle caddy 10 is maintained in an erected configuration whereupon removal of the baby bottles 14 removes all rigidity from the structure defined by series of compartments and walls and effects collapse thereof, as illustrated in FIG. 4 for example.”

The brief description of Figure 4 reads:

“FIG. 4 is a diagrammatic orthographic illustration taken in elevation of the baby bottle caddy of the instant invention from a first extended position to a second collapsed position upon removal of the baby bottles therefrom.”

In Figure 4, an arrow is used to indicate the direction of collapse of the baby bottle caddy 10 when it is in the collapsed position. As clearly shown in Figure 4, Strickland contemplates that once the bottles are removed the structure will tend to collapse towards the floor 13 - the collapse of the structure most likely being aided by gravity. Figure 4 does not show the direction of collapse to be towards the interior partition 12 (the common wall). Accordingly, it cannot be said that Strickland teaches that the internal compartment 11a is movable between an expanded position and a collapsed position relative to the interior partition 12.

Furthermore, Strickland neither teaches nor describes that internal compartment 11a is securable in a collapsed position. Nor has the applicant identified any reference in Strickland that shows this feature. Accordingly, Strickland cannot serve as an anticipatory reference as

it does not teach each and every feature of the applicant's claim 28. The applicant respectfully submits that claim 28 is allowable over Strickland.

In the event, the Examiner sustains his rejection of claim 28 on the basis of Strickland, it would be helpful if the Examiner could provide a column or line reference at which Strickland shows or describes how the internal compartment 11a is movable between expanded and collapsed positions relative to the interior partition 12 and is securable in a collapsed position; or (b) an annotated copy of any of figures of Strickland with these features identified.

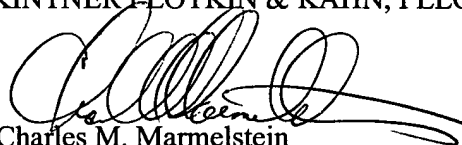
(4) **Conclusion**

In view of the foregoing arguments the applicant submits that all of claims 1, 2, 4 and 19 - 44 are presently allowable over the art of record in the case. Therefore the applicant requests early and favourable disposition of this application.

In the event that any fees are due with respect to this paper, please charge our Deposit Account No. 01-2300, referencing our docket number of 100570-00018.

Respectfully submitted,

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC



Charles M. Marmelstein  
Attorney for Applicant  
Reg. No. 25,895

Atty. Docket No.: 100570-00018

1050 Connecticut Avenue, N.W.  
Suite 400  
Washington, D.C. 20036-5339  
Tel (202) 857-6000  
Fax (202) 638-4810

CMM:mmg

Enclosure: Terminal Disclaimer Under 37 C.F.R. 1.321(c)